

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Ravi Ganesan et al

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:
: Group Art Unit: 3622
:
:

Serial No. 09/208,998

: Examiner: J. Young
:
:

Filed: December 11, 1998
:
:

For: TECHNIQUE FOR CONDUCTING SECURE TRANSACTIONS OVER A
NETWORK

REQUEST FOR ORAL HEARING

Honorable Assistant Commissioner
for Patents
Washington, DC 20231

Sir

An Oral Hearing before the Board of Patent Appeals and Interferences, pursuant to 35 C.F.R. 1.194 is hereby requested by the undersigned in the Appeal taken in the above-captioned utility application. A Credit Card Payment Form for the Hearing fee, in the amount of \$280.00 is enclosed.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 01-2135, including any patent application processing fees under 37 CFR 1.17.

Respectfully Submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

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AAS/sjg



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Ganesan et al.

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GROUP 3600

For: TECHNIQUE FOR CONDUCTING SECURE TRANSACTIONS OVER A NETWORK
TRANSMITTAL

Honorable Assistant Commissioner
for Patents
Washington, DC 20231

Sir:

Transmitted herewith is a Reply Brief in the above-identified application.

☐ No additional fee is required.

☒ Also attached: Request for Oral Hearing and Credit Card Payment form in the amount of \$280.00

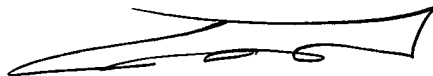
The fee (if applicable) has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	32	32	0	x \$18.00 =	\$0
Independent Claims	4	4	0	x \$84.00 =	\$0
Petition for ____ Month Extension of Time Fee					\$
Fee for Request for Oral Hearing					\$280.00
TOTAL FEE DUE					\$280.00

- [X] A Credit Card Payment Form in the amount of \$280.00 is attached
- [X] Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 01-2135, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully Submitted,

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Docket No. 3350-0029
File No. 1158.41322X00
Client No. WEBBCC

PATENT

Patricia Lewis
#25
1-14-03

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REPLY BRIEF

Honorable Assistant Commissioner
for Patents
Washington, DC 20231

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GROUP 3600

Sir:

This Reply Brief is submitted further to the Appeal Brief filed on August 26, 2002, and in response to the Examiner's Answer to the Appeal Brief issued on November 5, 2002.

I. THE EXAMINER ANSWER

As understood, the Examiner in Section (7) on page 3, alleges that the Appeal Brief fails to provide arguments supporting the grouping of the claims set forth in Section IX on page 16 of the Appeal Brief entitled "Grouping of Claims".

The Examiner, in Section (10), on pages 3-47, of the Examiner's Answer, reiterates

the reasons set forth for the rejection in the Final Office Action to which this appeal relates, and in Section (11), on pages 47-53, responds to the remarks presented in Section X of the Appeal Brief entitled "Arguments".

II. ARGUMENTS IN REPLY TO EXAMINER'S ANSWER

1) GROUPING OF CLAIMS

In Section IX of the Appeal Brief, it is asserted that "[e]ach of appealed claims 1, 9, 18, 21, 24 and 31 is in independent form. The various claimed embodiments/implementations of the invention are defined within groupings of claims (i) 1-8, (ii) 9-17, (iii) 18-20, (iv) 21-23, (v) 24-30 and (vi) 31 and 34. However, the claims of each group do not stand or fall together. Each of claims 1, 3, 4, 5, 6, 7, 9, 11, 12, 14, 15, 16, 18, 21, 24, 25, 26, 27, 28, 31, and 34 recite features which form an independent basis for allowance. Hence, claims 1, 2 and 8 stand and fall together, claim 3 stands and falls alone, claim 4 stands and falls alone, claim 5 stands and falls alone, claim 6 stands and falls alone, claim 7 stands and falls alone, claims 9, 10, 13 and 17 stand and fall together, claim 11 stands and falls alone, claim 12 stands and falls alone, claim 14 stands and falls alone, claim 15 stands and falls alone, claim 16 stands and falls alone, claims 18-20 stand and fall together, claims 21-23 stand and fall together, claims 24, 29 and 30 stand and fall together, claim 25 stands and falls alone, claim 26 stands and falls alone, claim 27 stands and falls alone, claim 28 stands and falls alone, claim 31 stands and falls alone, and claim 34 stands and falls alone."

As understood, the Examiner contends that the independent basis for allowance of claims 1, 3, 4, 5, 6, 7, 9, 11, 12, 14, 15, 16, 18, 21, 24, 25, 26, 27, 28, 31, and 34 is not supported in Section X (i.e. ARGUMENTS) of the Appeal Brief.

However, contrary to the Examiner's contention, arguments in support of the independent basis for each of the above-identified claims can be found in various portions of Section X. For example, grounds for allowance of each of independent claims 1, 9, 18, 21, 24 and 31 can be found on pages 21-27 of the Brief, for each of claims 4 and 12 on page 27 of the Brief, for each of claims 5 and 14 on page 28 of the Brief, for each of claims 6, 7, 15 and 16 on page 29 of the Brief, for each of claims 3 and 11 on page 40 of the Brief, for claim 25 on page 44 of the Brief, for each of claims 26, 27 and 28 on page 45 of the Brief, and for claim 34 on page 46 of the Brief.

2) LACK OF DUE PROCESS

It is applicant's position that the case history evidences a disregard for applicant's due process rights under the Constitution the United States of America, and that final rejection of the claims should be overturned on this basis alone.

In support, it is, for example, argued that the Examiner has failed to properly consider detailed arguments presented in traversal of the prior art rejections.

As evidence of this failure, applicant relies, for example, on the Examiner's assertion that entry of the Request for Reconsideration submitted responsive to the Final Official Action (which reiterated arguments previously submitted in response to the identical rejection in the prior non-final Official Action) is refused on the basis that the Request for Reconsideration raises issues which require further consideration, analysis,

and/or a search, and hence the Examiner's admission that the traversal arguments submitted prior to the final Official Action had not been properly considered.

It is also, for example, argued that the Examiner has failed to provide any reasonable or understandable basis for the rejection or for maintaining the rejection in view of the points explicitly raised in response to Official Actions.

As evidence of this failure, applicant relies, for example, on the Examiner's failure to provide any analysis as to how the applied Rosen anonymous payment by electronic currency, utilizing money modules, could be combined with the secure credit card transactions of Nguyen to result in the claimed invention. Instead, the Examiner provides only the bald assertion that "[i]t would have been obvious at the time the invention was made to a person having ordinary skill in the art to add the modification taught by Rosen '518 to Nguyen, because it would have been obvious that the disclosure of Rosen... would have been selected in accordance with 'the identity of the purchaser account being unknown to the seller' and because such modifications would have provided 'a system which will allow customers to buy electronic merchandise or services on demand'". Furthermore, notwithstanding the applicant; in response to the prior non-final Official Action, specifically noting this deficiency and requesting that the Examiner provide such analysis, no such analysis has been provided (see pages 13-14, bridging paragraph). Hence, the applicant has been provided with no understandable basis for the rejection of the claims.

It is additionally, for example, argued that the Examiner has failed to answer questions or provide clarification sought by applicants which is necessary in order to

understand the positions taken by the Examiner, in view of the inconsistencies between the Examiner's positions and the explicit teachings of the applied prior art.

As evidence of this failure, for example, as can be best understood the Examiner contends that it would have been obvious to add the unspecified modifications to the system disclosed by Nguyen, based on Rosen, because this would allow customers to buy electronic merchandise or services on demand. However, this objective is met by Nguyen alone (i.e. without such modification) and Nguyen's express objective is to avoid changes to conventional POS applications, and therefore appears to explicitly teach against the Examiner's proposed modification, which would require the use of Rosen's money modules and electronic money (e.g. cyber cash). Notwithstanding the applicant, in the response to the prior non-final Official Action, specifically noting the inconsistencies and requesting that the Examiner provide a clarification of the position taken, no clarification has been provided (see pages 26-27, bridging paragraph). Hence, the applicant is unable to reconcile the Examiner's positions with the applied prior art disclosures. Hence, applicant is unable to understand the rejection of the claims in view of the apparent inconsistencies with the applied prior art teachings. Other examples of these inconsistencies can, for example, also be found on page 27 (second full paragraph) through page 29 (penultimate paragraph).

The Examiner argues that constitutional due process is a formal matter and issues relating thereto should be petitioned to the Commissioner under 37 C.F.R. § 1.181. Applicant begs to differ. This is not a question of formalities, this is a question that goes to the heart of the fairness of the examination process.

In lieu of providing any substantive arguments or evidence relating to the conduct

of this prosecution to rebut the arguments presented, the Examiner's Answer makes more conclusionary assertions and out of context reference to the federal regulations and rules of practice. The Examiner, for example, asserts the conclusion that "in this case, the file wrapper indicates the instances of establishment of clear issues of patentability in consideration of Applicant's evidentiary offerings and rejection of the claimed invention," but fails to provide any objective support for the asserted conclusion.

The Examiner apparently has misunderstood Applicant's position. Applicant relies on the Examiner's conduct during the course of this prosecution solely as evidence. The Applicant is not seeking an exercise of supervisory authority or in any way requesting that the Board exercise supervisory authority over the Examiner. What Applicants are seeking is their constitutional due process rights. It is respectfully submitted that the facts in this case evidence that Applicant has not received a fair hearing and has not been allowed to be heard. Hence, applicant's due process rights have been violated, and that justice demands that the rejection be overturned.

3) FAILURE TO ESTABLISH PRIMA FACIE CASE

In the Appeal Brief, detailed analysis of why the Examiner has failed to establish a prima facie basis is provided in eight (8) pages (i.e., pages 22-29) of arguments. Within these arguments, objective evidence is presented for supporting a conclusion that the applied primary reference (i.e., Nguyen) explicitly teaches against the invention recited in claim 1 (see pages 22-24), and that the Examiner's proposed combination would result in an unworkable system according to Nguyen's own teachings (see page 24, last full paragraph), and that it is entirely speculative as to how the teachings of Rosen could be

used to modify Nguyen (see page 24, bridging paragraph, through page 25 penultimate paragraph). Additionally, various questions are raised in view of the objective evidence, such as, what the “anonymous transaction modifications” cited by the Examiner refer to and how the Examiner proposes to apply such modifications (see pages 25-26, bridging paragraph), what the Examiner’s objective basis is for various assertions made in support of the rejection (see page 26, first and second paragraphs), questions as to how the Examiner’s contentions can be reconciled with apparent inconsistencies of those assertions with the applied art disclosures (see pages 26-27, bridging paragraph and page 28, first full paragraph, through page 29), and the lack of analysis (see page 27, first full paragraph, through pages 27-28 bridging paragraph).

As can best be understood, the only substantive response provided by the Examiner to the numerous issues relating to the prima facie basis of the Examiner’s rejection of numerous claims, is that “in this case, Nguyen shows more than just one example of operation where the identity of the purchaser is unknown; for example, Nguyen (col. 1, ll. 65-67; and col. 2, ll. 1-36) shows electronic funds transactions where the identity of the purchaser account is not unknown. Therefore, in response to arguments in Applicant’s Brief that combining Rosen with Nguyen for the purpose of modifying Nguyen, the two references would render the Nguyen reference unsuitable for its intended purpose; neither reference would change the principle operation of the other because In re Ratti, (citation omitted) combination of the references would ... [NOT] require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate ... In other words, the teachings of Nguyen would not be inoperable

for its intended purpose by conducting electronic funds transactions with the identity of the purchaser either disclosed or unknown".

It is respectfully submitted that the Answer is not understood. The Examiner provides no support for the statement that "Nguyen shows more than just one example of operation where the identity of the purchaser is unknown." Furthermore, the relevance of the Examiner's assertion that "Nguyen shows more than just one example of operation where the identity of the purchaser is unknown" is not understood, since the relevant limitation relates to whether or not the identity of the purchaser account is unknown, not whether or not the identity of the purchaser is unknown.

In the Examiner's statement relating to the citation in columns 1 and 2 (i.e., text in the background of the invention section), the Examiner indicates that Nguyen is describing electronic fund transactions where the identity of the purchaser account is known. However, the specific text referenced by the Examiner in columns 1 and 2 discusses prior art electronic fund transfer systems which are examples of home banking bill payment services, and the use of "electronic money". The referenced text lacks any disclosure of whether a purchaser's identity or a purchaser's account is known or unknown.

Furthermore, even if the Examiner's contention is correct and Nguyen shows "electronic funds transactions where the identity of the purchaser account is not unknown" and accordingly is known, the relevant claims, such as claim 1, require that the purchaser account be unknown.

The Examiner's reliance on In re Ratti is also not understood. The cited text from the case relates to the particular facts of that case. Hence, it is unclear how the cited case text supports the conclusionary assertion that "the teachings of Nguyen would not be

inoperable for its intended purpose by conducting electronic funds transactions with the identity of the purchaser either disclosed or unknown". The Examiner does not provide one iota of objective support for the asserted conclusion. Furthermore, the relevant limitation, such as in claim 1, relates to the identity of the purchaser account, not the purchaser.

4) LACK OF MOTIVATION FOR PROPOSED COMBINATION

On pages 30-36 of the Brief, detailed objective evidence is presented to show a lack of motivation to combine the Nguyen and Rosen references. As pointed out therein, the Examiner acknowledges that Nguyen fails to disclose that the identity of the purchaser account is unknown to the seller, and proposes to modify Nguyen based on the teachings of Rosen to make obvious the invention of the relevant claims, such as claim 1.

As detailed in the Appeal Brief, Rosen discloses two techniques for payment. In the first technique, a payment is made anonymously by transferring electronic notes between a money module at the purchaser and a money module at the seller. Hence, in the first technique payments are not made from deposit or credit accounts maintained at a financial institute as required by the relevant claims. In Rosen's second technique, payment is identity based and includes a charge to a debit or credit card, with the seller (e.g., the seller's agent) being made aware of the identity of the purchaser's account.

Accordingly, the Examiner's asserted motivation does not exist, since Rosen teaches separate identity based and nonidentity based payment techniques. Therefore, there is no motivation to combine Rosen's nonidentity based (anonymous) payment technique with Nguyen's identity based credit card payment technique. In fact, Rosen

itself teaches against such a combination, as Rosen has clearly concluded that credit card payments, unlike electronic money payments (in which payment is made by a transfer from a credit account at a financial institute), inherently require a revealing of the purchaser's account number.

The Examiner responds to these arguments by baldly asserting "in this case, the prior Office Action relies upon modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Therefore, the prior Office Action provided (rationale as to how one could modify Nguyen with the teaches of Rosen ..."

It is respectfully submitted that, as in the prior Official Actions, the Examiner again provides no objective evidence rebutting the traversal arguments presented. Rather, the Examiner relies solely on conclusionary statements and circular arguments in support of his position.

5) FAILURE OF APPLIED REFERENCES TO SUGGEST CLAIMED INVENTION

On pages 38-46, detailed objective evidence is presented in support of the traversal of the obviousness holding. In this regard issues are raised as to how one would go about modifying Nguyen in view of Rosen and what the result of the proposed combination would be. Furthermore, it is further asserted that even if one could somehow modify Nguyen as proposed by the Examiner, such that the purchaser account number is not disclosed to the seller (i.e., could somehow modify Nguyen in view of Rosen's anonymous payment technique), the payment would be made by a transfer of electronic

money on deposit in the purchaser's money module at the purchaser's CTD and not by a transfer to the seller of funds on deposit in or credited to an account of the purchaser maintained at a financial institute, as required by the relevant claims.

Numerous other features lacking in the proposed combination are also explicitly discussed. However, the Examiner has opted not to respond to any of the arguments presented in this regard in the Answer.

6) HINDSIGHT RECONSTRUCTION/PURE SPECULATION

In reply to the arguments presented in the Appeal Brief that the rejection is based on either an improper hindsight reconstruction or pure speculation, the Examiner again baldly asserts that "in this case, in the prior Office Action, the reconstruction based upon hindsight reasoning only took into account "knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper". However, the Examiner provides no support whatsoever for this statement.

The Examiner further asserts that he has not admitted "that the primary reference does not teach elements of the instant invention". The Examiner goes on to assert "terminology such as 'lacks an explicit recital ...' is merely the transition phraseology to the factual inquiries set forth in Graham v. John Deere Co. (citation omitted)". The Examiner additionally asserts that "obviousness proposition that the reference suggests the claimed elements and limitations of the instant invention".

The assertions are not understood. The Examiner explicitly acknowledges that, for example, the primary Nguyen reference does not teach the identity of the deposit or credit

account remaining unknown to the seller, and attempts to overcome this deficiency using the teachings of Rosen. It is unclear what relationship the Answer presented by the Examiner has to the Examiner's prior acknowledgment. It is therefore again respectfully submitted that, based upon the Examiner's failure to establish a prima facie case for the rejection or to provide any reasonable support for the rejections, it can only be concluded that the Examiner has attempted an improper hindsight reconstruction of the invention or has based the rejection on pure speculation.

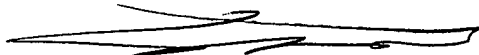
In conclusion, it is respectfully submitted that (i) the applicant's due process rights under the Constitution have been violated, (ii) the Examiner has failed to establish a prima facie case for the rejection, (iii) the Examiner has proposed to combine art without motivation, (iv) the Examiner has failed to apply art which teaches or suggests the claimed invention and (v) the Examiner has at best attempted an improper hindsight reconstruction of the invention or relied on pure speculation.

Thus, it is respectfully submitted that the rejection of claims 1-31 and 34 under 35 U.S.C. §103(a), is in error and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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